

1 COOLEY LLP
 2 BOBBY GHAJAR (198719)
 3 JOHN HEMANN (165823)
 4 JUDD D. LAUTER (290945)
 5 3 Embarcadero, 20th Floor
 6 San Francisco, CA 94111-4004
 7 Telephone: (650) 843-5000
 8 Email: bghajar@cooley.com
 9 jhemann@cooley.com
 10 jlauter@cooley.com

11 DAVID CHIU (189542)
 12 City Attorney
 13 JESSE SMITH (122517)
 14 Chief Assistant City Attorney
 15 YVONNE R. MERÉ (173594)
 16 Chief Deputy City Attorney
 17 JULIE VEIT (209207)
 18 CHRISTOPHER STUART (262399)
 19 Deputy City Attorneys
 20 City Hall
 21 1 Dr. Carlton B. Goodlett Place
 22 San Francisco, California 94102-4682
 23 Telephone: (415) 554-4700
 24 Facsimile: (415) 554-4757
 25 Email: Cityattorney@sfcityatty.org
 26 Jesse.Smith@sfcityatty.org
 27 Yvonne.Mere@sfcityatty.org
 28 Julie.Veit@sfcityatty.org
 29 Christopher.Stuart@sfcityatty.org

30 Attorneys for Plaintiff
 31 CITY AND COUNTY OF SAN FRANCISCO

32 **UNITED STATES DISTRICT COURT**

33 **NORTHERN DISTRICT OF CALIFORNIA**

34 CITY AND COUNTY OF SAN FRANCISCO,

35 Case No. 3:24-cv-02311-TSH

36 Plaintiff and Counterclaim-
 37 Defendant,

**PLAINTIFF AND COUNTERCLAIM
 DEFENDANT CITY AND COUNTY OF
 SAN FRANCISCO'S ANSWER TO
 DEFENDANT PORT OF OAKLAND'S
 COUNTERCLAIM FOR
 DECLARATORY RELIEF**

38 v.

39 CITY OF OAKLAND AND PORT OF
 40 OAKLAND,

41 Defendants and
 42 Counterclaim Plaintiff.

43 **AND RELATED COUNTERCLAIM**

1 Plaintiff and Counterclaim-Defendant City and County of San Francisco (the “City” or
 2 “Plaintiff”) hereby responds to the declaratory relief counterclaim (the “Counterclaim”) filed by
 3 Defendant and Counterclaim-Plaintiff the Port of Oakland (the “Port”) on May 9, 2024. As set
 4 forth below, the Counterclaim is merely a mirror image of the Port’s defense to the City’s trademark
 5 and unfair competition claims. The City denies all allegations in the Counterclaim that are not
 6 specifically admitted below, and further denies that the Port is entitled to the relief requested in the
 7 Counterclaim or to any other relief.

8 SAN FRANCISCO’S INTRODUCTORY COMMENTS

9 This is a trademark case brought by the City to stop the Port’s brazen trademark
 10 infringement and to protect consumers and the public from confusion caused by the rebranding of
 11 Oakland International Airport to **San Francisco Bay Oakland International Airport** (the
 12 “Infringing Mark”). The City’s Motion for Preliminary Injunction (Dkt. 35) explains why the Court
 13 should enjoin Defendants’ use of the Infringing Mark. In an attempt to deflect from its misconduct,
 14 the Port filed a “counterclaim,” which is just an amplified denial of its infringement adorned with
 15 self-serving allegations about Oakland and its airport – concluding with a request that the Court
 16 find that its Infringing Mark is “not likely to cause confusion, or to cause mistaken, or to deceive
 17 as to the affiliation, connection, or association of [Oakland’s airport] with the [City].” (Dkt. 15 at
 18 ¶¶97-102). The evidence proves otherwise. The Port’s counterclaim is an improper “declaratory
 19 judgment” claim that is merely the mirror image of its purported defense. It should be denied.

20 THE CITY’S RESPONSE TO THE SECTION ENTITLED “INTRODUCTION” (¶¶1-15)

21 1. The City admits that on May 9, the Board of Port Commissioners of the Port of
 22 Oakland voted to change the name of its Airport from to “San Francisco Bay Oakland International
 23 Airport.” The City denies the Port’s characterization of the Oakland airport’s name change as
 24 consisting of replacing “Metropolitan” with “San Francisco Bay.” The City lacks knowledge and
 25 information sufficient to form a belief as to the truth of the remaining allegations set forth in
 26 paragraph 1, and on that basis denies the same.

27 2. The City denies that paragraph 2 depicts that the Oakland Airport has a “distinctive
 28 brand,” as that brand is a copy of the City’s famous, uncontested registered trademark. The City

1 lacks knowledge and information sufficient to form a belief as to the truth of the remaining
 2 allegations set forth in paragraph 2, and on that basis denies the same.

3 3. The City denies that the Port's purported continued use of the IATA code OAK
 4 will continue to provide "smooth operations for travelers to the San Francisco Bay area." The
 5 opposite is true. The City lacks knowledge and information sufficient to form a belief as to the
 6 truth of the remaining allegations set forth in paragraph 3, and on that basis denies the same.

7 4. The City lacks information sufficient to form a belief as to the truth of the
 8 allegations set forth in paragraph 4, and on that basis denies the same.

9 5. The City denies the allegations in paragraph 5.

10 6. The City lacks knowledge and information sufficient to form a belief as to the truth
 11 of the remaining allegations set forth in paragraph 6, and on that basis denies the same.

12 7. The City denies any characterization by the Port that the City should support the
 13 Port's brazen infringement of the City's famous SAN FRANCISCO INTERNATIONAL
 14 AIRPORT® trademark. The City lacks knowledge and information sufficient to form a belief as to
 15 the truth of the Port's allegation that "people who live in San Francisco stand to benefit from more
 16 airline route choices and price competition," and on that basis denies the same. The City admits the
 17 remaining allegations in Paragraph 7 relating to the City's opposition to the Port's Board's vote to
 18 adopt the Infringing Mark.

19 8. The City admits that it filed this lawsuit against the Port and the City of Oakland
 20 several weeks prior to the Port's filing of the declaratory relief counterclaim and prior to the Port's
 21 second meeting providing final approval for the change of the Oakland airport's name to SAN
 22 FRANCISCO BAY OAKLAND INTERNATIONAL AIRPORT. The City denies the remaining
 23 allegations in paragraph 8.

24 9. The City admits that the Port's trademark, SAN FRANCISCO BAY OAKLAND
 25 INTERNATIONAL AIRPORT, infringes the City's rights in the SAN FRANCISCO
 26 INTERNATIONAL AIRPORT mark. The City denies the remaining allegations in paragraph 9.

27 10. The City admits that the San Francisco International Airport is located south of San
 28 Francisco, mostly in an unincorporated area of San Mateo County, and that the airport provides

1 domestic and international flights for travel into the Bay Area and downtown San Francisco. The
 2 City further admits that the Oakland airport also provides domestic and international flights for
 3 travel into the Bay Area, and that the Oakland airport is on the Bay. The City denies the remaining
 4 allegations in paragraph 10.

5 11. The allegations in this paragraph, like many, are irrelevant. Nonetheless, the City
 6 denies that the acronym “BART” stands for “San Francisco Bay Area Rapid Transit.” The City
 7 admits the remaining allegations in paragraph 11 relating to BART’s service area.

8 12. The City denies the allegations in paragraph 12.

9 13. The City denies the allegations in paragraph 13.

10 14. The City denies the allegations in paragraph 14.

11 15. The City denies that the Port is entitled to the relief requested in paragraph 15. The
 12 City lacks knowledge and information sufficient to form a belief as to the truth of the remaining
 13 allegations set forth in paragraph 15, and on that basis denies the same.

THE CITY’S RESPONSE TO THE SECTION ENTITLED “PARTIES”

15 16. The City admits on belief that the Port’s principal place of business is 530 Water
 16 Street, Oakland, California 94607. The remaining allegations in paragraph 16 state legal
 17 conclusions to which no response is required. To the extent a response is deemed required, the City
 18 lacks knowledge and information sufficient to form a belief as to the truth of the remaining
 19 allegations set forth in paragraph 16, and on that basis denies the same.

20 17. The City admits the allegations in paragraph 17.

21 18. The City admits the allegations in paragraph 18.

22 19. The City admits the allegations in paragraph 19.

THE CITY’S RESPONSE TO THE SECTION ENTITLED “JURISDICTION AND VENUE”

25 20. The allegations in paragraph 20 state legal conclusions to which no response is
 26 required. To the extent a response is deemed required, the City denies the allegations in paragraph

27 20.

28

1 21. The allegations in paragraph 21 state legal conclusions to which no response is
 2 required. To the extent a response is deemed required, the City admits that the Court has personal
 3 jurisdiction over the City relating to the allegations in this lawsuit.

4 22. The allegations in paragraph 22 state legal conclusions to which no response is
 5 required. To the extent a response is deemed required, the City admits that venue is appropriate
 6 with this Court.

7 **THE CITY'S RESPONSE TO THE SECTION ENTITLED "FACTUAL ALLEGATIONS"**

8 23. The City lacks knowledge and information sufficient to form a belief as to the truth
 9 of the allegations set forth in paragraph 23, and on that basis denies the same.

10 24. The City lacks knowledge and information sufficient to form a belief as to the truth
 11 of the allegations set forth in paragraph 24, and on that basis denies the same.

12 25. The City lacks knowledge and information sufficient to form a belief as to the truth
 13 of the allegations set forth in paragraph 25, and on that basis denies the same.

14 26. The City lacks knowledge and information sufficient to form a belief as to the truth
 15 of the allegations set forth in paragraph 26, and on that basis denies the same.

16 27. The City lacks knowledge and information sufficient to form a belief as to the truth
 17 of the allegations set forth in paragraph 27, and on that basis denies the same.

18 28. The City lacks knowledge and information sufficient to form a belief as to the truth
 19 of the allegations set forth in paragraph 28, and on that basis denies the same.

20 29. The City lacks knowledge and information sufficient to form a belief as to the truth
 21 of the allegations set forth in paragraph 29, and on that basis denies the same.

22 30. The City lacks knowledge and information sufficient to form a belief as to the truth
 23 of the allegations set forth in paragraph 30, and on that basis denies the same.

24 31. The City lacks knowledge and information sufficient to form a belief as to the truth
 25 of the allegations set forth in paragraph 31, and on that basis denies the same.

26 32. The City lacks knowledge and information sufficient to form a belief as to the truth
 27 of the allegations set forth in paragraph 32, and on that basis denies the same.

28

1 33. The City admits that the Oakland airport is located on the Bay. The City lacks
 2 knowledge and information sufficient to form a belief as to the truth of the remaining allegations
 3 set forth in paragraph 33, and on that basis denies the same.

4 34. The City lacks knowledge and information sufficient to form a belief as to the truth
 5 of the allegations set forth in paragraph 34, and on that basis denies the same.

6 35. The City lacks knowledge and information sufficient to form a belief as to the truth
 7 of the allegations set forth in paragraph 35, and on that basis denies the same.

8 36. The City lacks knowledge and information sufficient to form a belief as to the truth
 9 of the allegations set forth in paragraph 36, and on that basis denies the same.

10 37. The City lacks knowledge and information sufficient to form a belief as to the truth
 11 of the allegations set forth in paragraph 37, and on that basis denies the same.

12 38. The City lacks knowledge and information sufficient to form a belief as to the truth
 13 of the allegations set forth in paragraph 38, and on that basis denies the same.

14 39. The City lacks knowledge and information sufficient to form a belief as to the truth
 15 of the allegations set forth in paragraph 39, and on that basis denies the same.

16 40. The City lacks knowledge and information sufficient to form a belief as to the truth
 17 of the allegations set forth in paragraph 40, and on that basis denies the same.

18 41. The City lacks knowledge and information sufficient to form a belief as to the truth
 19 of the allegations set forth in paragraph 41, and on that basis denies the same.

20 42. The City lacks knowledge and information sufficient to form a belief as to the truth
 21 of the allegations set forth in paragraph 42, and on that basis denies the same.

22 43. The City admits that over a period of decades, the Port has built additional terminals
 23 at the Oakland airport and routes to the airport subsequently increased. The City lacks knowledge
 24 and information sufficient to form a belief as to the truth of the remaining allegations set forth in
 25 paragraph 43, and on that basis denies the same.

26 44. The City lacks knowledge and information sufficient to form a belief as to the truth
 27 of the allegations set forth in paragraph 44, and on that basis denies the same.

28

1 45. The City denies that the acronym “BART” stands for “San Francisco Bay Area
 2 Rapid Transit.” The City lacks knowledge and information sufficient to form a belief as to the truth
 3 of the remaining allegations set forth in paragraph 45, and on that basis denies the same.

4 46. The City admits that the Port has at times used the logo depicted in paragraph 46.
 5 The City lacks knowledge and information sufficient to form a belief as to the truth of the remaining
 6 allegations set forth in paragraph 46, and on that basis denies the same.

7 47. The City lacks knowledge and information sufficient to form a belief as to the truth
 8 of the remaining allegations set forth in paragraph 47, and on that basis denies the same.

9 48. The City admits that publicly accessible records from the U.S. Patent and
 10 Trademark Office indicate that the Port owns U.S. Registration Nos. 6122118 and 6122119, and
 11 that these registrations formerly corresponded to Application Serial Nos. 88506555 and 88506558.
 12 The City lacks knowledge and information sufficient to form a belief as to the truth of the remaining
 13 allegations set forth in paragraph 48, and on that basis denies the same.

14 49. The City admits the allegations in Paragraph 49.

15 50. The City lacks knowledge and information sufficient to form a belief as to the truth
 16 of the allegations set forth in paragraph 50, and on that basis denies the same.

17 51. The City admits that travelers may travel where they wish. The City otherwise
 18 lacks knowledge and information sufficient to form a belief as to the truth of the allegations set
 19 forth in paragraph 51, and on that basis denies the same.

20 52. The City lacks knowledge and information sufficient to form a belief as to the truth
 21 of the allegations set forth in paragraph 52, and on that basis denies the same.

22 53. The City lacks knowledge and information sufficient to form a belief as to the truth
 23 of the allegations set forth in paragraph 53, and on that basis denies the same.

24 54. The City lacks knowledge and information sufficient to form a belief as to the truth
 25 of the allegations set forth in paragraph 54, and on that basis denies the same.

26 55. The City lacks knowledge and information sufficient to form a belief as to the truth
 27 of the allegations set forth in paragraph 55, and on that basis denies the same.

28

1 56. The City lacks knowledge and information sufficient to form a belief as to the truth
 2 of the allegations set forth in paragraph 56, and on that basis denies the same.

3 57. The City lacks knowledge and information sufficient to form a belief as to the truth
 4 of the allegations set forth in paragraph 57, and on that basis denies the same.

5 58. The City lacks knowledge and information sufficient to form a belief as to the truth
 6 of the allegations set forth in paragraph 58, and on that basis denies the same.

7 59. The City lacks knowledge and information sufficient to form a belief as to the truth
 8 of the allegations set forth in paragraph 59, and on that basis denies the same.

9 60. The City lacks knowledge and information sufficient to form a belief as to the truth
 10 of the allegations set forth in paragraph 60, and on that basis denies the same.

11 61. The City lacks knowledge and information sufficient to form a belief as to the truth
 12 of the allegations set forth in paragraph 61, and on that basis denies the same.

13 62. The City lacks knowledge and information sufficient to form a belief as to the truth
 14 of whether Chicago Rockford International Airport (RFD) serves the Chicago area. The City
 15 admits the remaining allegations in paragraph 62, without admitting the relevance of the names of
 16 non-U.S. airports.

17 63. The City lacks knowledge and information sufficient to form a belief as to the truth
 18 of the allegations set forth in paragraph 63, and on that basis denies the same.

19 64. The City denies the allegations in paragraph 64 to the extent it suggests that the
 20 logo depicted therein is the only way that consumers have and will encounter the Infringing Mark.

21 65. The City lacks knowledge and information sufficient to form a belief as to the truth
 22 of the allegations set forth in paragraph 65, and on that basis denies the same.

23 66. The City admits the allegations in paragraph 66.

24 67. The City lacks knowledge and information sufficient to form a belief as to the truth
 25 of the allegations set forth in paragraph 67, and on that basis denies the same.

26 68. The City admits that it objected – as did many – to the Infringing Mark.

27 69. The City lacks knowledge and information sufficient to form a belief as to the truth
 28 of the allegations set forth in paragraph 69, and on that basis denies the same. As with many of the

1 other allegations in the Counterclaim, the City denies the relevance of this allegation to the issue
 2 of Defendants' trademark infringement.

3 70. The City lacks knowledge and information sufficient to form a belief as to the truth
 4 of the allegations set forth in paragraph 70, and on that basis denies the same.

5 71. The City admits the allegations in paragraph 71 regarding the public meeting held
 6 to consider the first reading of the Ordinance for the proposed name change.

7 72. The City admits that at the April 11, 2024 public meeting, the Port's Interim
 8 Director of Aviation ("Aviation Director") presented a recommendation to change the Oakland
 9 airport's name to SAN FRANCISCO BAY OAKLAND INTERNATIONAL AIRPORT. The City
 10 denies that the airport's new name is "accurate." The City lacks knowledge and information
 11 sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 72, and
 12 on that basis denies the same.

13 73. The City lacks knowledge and information sufficient to form a belief as to the truth
 14 of the allegations set forth in paragraph 73, and on that basis denies the same.

15 74. The City lacks knowledge and information sufficient to form a belief as to the truth
 16 of the allegations set forth in paragraph 74, and on that basis denies the same.

17 75. The City lacks knowledge and information sufficient to form a belief as to the truth
 18 of the allegations set forth in paragraph 75, and on that basis denies the same.

19 76. The City lacks knowledge and information sufficient to form a belief as to the truth
 20 of the allegations set forth in paragraph 76, and on that basis denies the same.

21 77. The City lacks knowledge and information sufficient to form a belief as to the truth
 22 of the allegations set forth in paragraph 77, and on that basis denies the same.

23 78. The City lacks knowledge and information sufficient to form a belief as to the truth
 24 of the allegations set forth in paragraph 78, and on that basis denies the same.

25 79. The City lacks knowledge and information sufficient to form a belief as to the truth
 26 of the allegations set forth in paragraph 79, and on that basis denies the same.

27 80. The City lacks knowledge and information sufficient to form a belief as to the truth
 28 of the allegations set forth in paragraph 80, and on that basis denies the same.

1 81. Based on Defendants' eventual adoption and use of the Infringing Mark, the City
 2 admits the allegations in paragraph 81.

3 82. The allegations in paragraph 82 state legal conclusions to which no response is
 4 required. To the extent a response is deemed required, the City lacks knowledge and information
 5 sufficient to form a belief as to the truth of the allegations set forth in paragraph 82, and on that
 6 basis denies the same.

7 83. The allegations in paragraph 83 state legal conclusions to which no response is
 8 required. To the extent a response is deemed required, the City lacks knowledge and information
 9 sufficient to form a belief as to the truth of the allegations set forth in paragraph 83, and on that
 10 basis denies the same.

11 84. The City admits that the Board set a second meeting for May. The City lacks
 12 knowledge and information sufficient to form a belief as to the truth of the remaining allegations
 13 set forth in paragraph 84, and on that basis denies the same.

14 85. The allegations in paragraph 85 state legal conclusions to which no response is
 15 required. To the extent a response is deemed required, the City lacks knowledge and information
 16 sufficient to form a belief as to the truth of the allegations set forth in paragraph 85, and on that
 17 basis denies the same.

18 86. The City admits that it filed its lawsuit in this action prior to the Port's second
 19 meeting concerning the change of the Oakland airport's name to SAN FRANCISCO BAY
 20 OAKLAND INTERNATIONAL AIRPORT. The City denies the remaining allegations in
 21 paragraph 86.

22 87. The City admits that it filed a lawsuit. The content of the Complaint speaks for
 23 itself.

24 88. Again, the content of the City's Complaint speaks for itself. The City denies that
 25 the Port's infringement is "purported[]," and denies that the Port's infringement is due only to
 26 confusion of travelers whom book flights to the Oakland airport intending to depart from the City's
 27 airport.

28 89. The City denies the allegations in paragraph 89.

1 90. The City admits that some passengers booking flights to the Bay Area may
 2 understand that the Bay Area may contain more than one airport. The City lacks knowledge and
 3 information sufficient to form a belief as to the truth of the remaining allegations set forth in
 4 paragraph 90, and on that basis denies the same.

5 91. The City denies that the Port's "I FLY OAK" logo and branding have been
 6 "retained" or that sometimes appending a logo to an infringing trademark might eliminate
 7 trademark infringement or consumer confusion. The City lacks knowledge and information
 8 sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 91, and
 9 on that basis denies the same.

10 92. The City denies the allegations in paragraph 92.

11 93. The City denies the allegations in paragraph 93.

12 94. The City denies that its allegations are "balderdash" or that it is not entitled to
 13 enforce its trademark rights in the SAN FRANCISCO INTERNATIONAL AIRPORT trademark
 14 against the Port's Infringing Mark. The City further denies that its allegations are a "contrived
 15 rationale to thwart a geographic fact." The City lacks knowledge and information sufficient to form
 16 a belief as to the truth of the remaining allegations set forth in paragraph 94, and on that basis denies
 17 the same.

18 THE CITY'S RESPONSE TO "CLAIM FOR RELIEF: DECLARATORY JUDGMENT"

19 95. The City incorporates by reference its responses to paragraphs 1 through 94 above
 20 as though fully set forth herein.

21 96. The allegations in paragraph 96 state legal conclusions to which no response is
 22 required. To the extent a response is deemed required, the City admits that the Port disputes the
 23 City's allegations of trademark infringement. The City denies the remaining allegations in
 24 paragraph 96.

25 97. The allegations in paragraph 97 state legal conclusions to which no response is
 26 required. To the extent a response is deemed required, the City admits that the Port disputes the
 27 City's allegations of trademark infringement. The City denies the remaining allegations in
 28 paragraph 97.

98. The City denies the allegations in paragraph 98.

99. The City denies the allegations in paragraph 99.

100. The City denies the allegations in paragraph 100.

101. The City denies the allegations in paragraph 101.

102. The City denies the allegations in paragraph 102.

THE CITY'S RESPONSE TO "JURY DEMAND"

The section titled "Jury Demand" states legal conclusions to which no response is required.

The City nonetheless agrees that its claims should be tried to a jury.

THE CITY'S RESPONSE TO "PRAYER FOR RELIEF"

The City denies that the Port is entitled to any relief whatsoever, including but not limited to the relief sought in the section of the Counterclaim titled “Prayer for Relief.” To the extent a response to this section is required, the City denies the same.

THE CITY'S AFFIRMATIVE DEFENSES

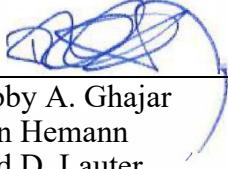
The City asserts that the Port's claims are barred, in whole or in part, by the defenses set forth herein. By setting forth these defenses, the City does not assume the burden of proving any fact, issue, or element of a cause of action where such burden properly belongs to the Port. The City reserves the right to plead any and all defenses that may be evident or appreciated after investigation and discovery in this matter.

FIRST AFFIRMATIVE DEFENSE

The Counterclaim fails to state a claim upon which relief can be granted because the Counterclaim seeks an improper advisory opinion concerning uses of the Port's infringing SAN FRANCISCO BAY OAKLAND INTERNATIONAL AIRPORT trademark independent of the full commercial context in which consumers encounter them. The City intends to move for judgment as to the Counterclaim at the appropriate time.

1 Dated: October 1, 2024

COOLEY LLP

2
3 By: 
4 Bobby A. Ghajar
John Hemann
Judd D. Lauter

5 Attorneys for Plaintiff
6 CITY AND COUNTY OF
7 SAN FRANCISCO

10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28